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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,819	06/10/2004	Holger Warth	Mo-7019N/LeA 33,428-N	3370
157	7590	01/09/2006	EXAMINER	
BAYER MATERIAL SCIENCE LLC			MULLIS, JEFFREY C	
100 BAYER ROAD			ART UNIT	
PITTSBURGH, PA 15205			PAPER NUMBER	

1711

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/776,819	Applicant(s) WARTH ET AL.	
	Examiner Jeffrey C. Mullis	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claim 16 contains the misspelling "slectron" (sic, electron). Correction is required.

Claims 15-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The "random (co)polymer(s)" of claim 15 and especially of B.1.1 and B1.2 were not disclosed by the specification as filed and are therefore new matter. Furthermore the specification does not disclose how to produce copolymers of polymers such as polyurethanes or silicones etc.

The particle size as determined by electron micrographs of claim 18 lacks support in the specification as filed.

Claims 15-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what a copolymer of a polymer such as a copolymer of a polyurethane would encompass as recited by claim 15 since copolymers pertain to monomers, not polymers. Furthermore the term "(co)polymer" encompasses both polymers and copolymers while the term "random" pertains only to copolymers not non copolymer materials and the claims are thus contradictory. The following is a quotation of 35

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U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katayama et al. (US 6,316,579).

Katayama discloses a composition "diene-series block copolymer" "F" which is modified by grafting (column 8, lines 42-45) which is present at a level of 0.1-30 parts per 100 parts of polycarbonate (column 3, lines 10-18) and in which is present a "second thermoplastic resin (3)" at a level of polycarbonate/resin of 99/1 to 1/99 (column 3, lines 19-31) along with 1-40 parts of flame retardant (column 3, lines 31-36). The second thermoplastic includes PEN at column 9, lines 21-27, while the flame retardant may include applicants phosphates at the paragraph bridging columns 14 and 15. Vinyl resins may be included at column 12, lines 22-53.

No Examples are present in the reference having all of applicants' materials in applicants' amounts in combination, although such lies within the broad ambit of the reference. However, choice of such would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results, absent any showing of surprising or unexpected results.

Claims 15 and 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noriyuki et al., JP 10-245481.

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Note the abstract of the patent for a composition having all of applicants' components and in ranges embracing applicants amounts as well as the examples in which are used applicants materials in amounts which are similar to applicants.

No Examples are present in the reference having all of applicants' materials in applicants' amounts in combination, although such lies within the broad ambit of the reference. However, choice of such would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results, absent any showing of surprising or unexpected results.

Applicant's arguments filed 10-26-05 have been fully considered but they are not persuasive. Applicants argue unexpected results based on "melt volume rate" and "natural color tone". However these terms are not art recognized and it is unclear that they pertain to some benefit as required for unexpected results. Furthermore, if the "melt volume rate" and "natural color tone" of PEN and PENCO by themselves are superior to "Comp" then improvement of "melt volume rate" and natural "color tone" upon addition to "Comp" is not unexpected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 571 272 1075.

Jeffrey C. Mullis
J Mullis
Art Unit 1711

JCM

12-28-05

Jeffrey Mullis
Primary Examiner
Art Unit 1711

